

REMARKS

Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97, and 99-103 are pending in the application. Claims 1, 22, 91 and 102 have been amended. No new matter has been added.

Applicants thank the Examiner for withdrawing previous rejections under 35 U.S.C. §102 and 35 U.S.C. § 112, second paragraph. Applicants also thank the Examiner for withdrawing the previous objection to the specification.

With respect to paragraph 4 of the present Office Action, Applicants wish to request clarification of the withdrawal of a previous objection to the claims. The Examiner in the Office Action mailed May 10, 2005, references paragraph 5 of the November 22, 2004 Office Action in his withdrawal of objections to the claims. Applicants believe the Examiner intended to reference paragraph 9 (see objection in Office Action mailed November 22, 2004) and Applicants invite the Examiner to clarify this.

The Examiner's remarks in the last Office Action are addressed below. It is believed that the amended claims and all dependent claims, taken in light of the remarks made herein, meet all criteria for patentability.

CLAIM REJECTIONS

Rejection of claims under 35 U.S.C. §112, first paragraph

The Examiner has rejected claims 1-5, 7-8, 12-13, 16-17, 22, 25-26, 80-94, 96, 97, and 99-103 under 35 U.S.C. §112, first paragraph. See page 3 of Office Action.

According to the MPEP 2164.01(a), the Examiner's analysis of whether a disclosure is enabling must be based on "all evidence related to each" of the Wands factors, "and any conclusion of nonenablement must be based on the evidence as a whole." The Examiner has acknowledged that Applicants have provided direction for the synthesis of compounds in which Y² connects to the group C(X¹)X²H via a heteroatom such as nitrogen or oxygen. The Examiner however, contends that such compounds are "known to be inherently unstable" and require undue experimentation "to make and use the claimed invention since formation of these compounds is not enabled [and] neither is their use." See page 4 of Office Action. The Examiner has not provided any support for the contention that such compounds are "known to be inherently unstable."

Applicants respectfully submit that “[a]s long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied.” See MPEP 2164.01(b). Further, the lack of a working example in which Y^2 connects to the group $C(X^1)X^2H$ via a heteroatom, should only be considered only in cases that involve “an unpredictable and undeveloped art.” “The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation.” See MPEP 2164.01. In this respect, the Examiner has acknowledged that “the state of the prior art in synthesis is generally considered high.” See page 4 of Office Action. Accordingly, as the Applicants have provided an enabling disclosure, Applicants do not need to provide a working example.

Moreover, compounds of formula (I) in which Y^2 is a heteroatom can be made and are stable, although the stability of the compounds can depend on conditions. If the Examiner continues to contend that the compounds are “known to be inherently unstable,” Applicants respectfully request that the Examiner provide support for the contention of instability. Applicants respectfully request reconsideration and withdrawal of this rejection.

Rejection of claims under 35 U.S.C. §102(b)

Nakane

The Examiner has rejected claims 1-5, 22, and 102 under 35 U.S.C. §102(b) as being anticipated by U.S Patent No. 4,663,336 to Nakane et al. (“Nakane”). Claims 1, 22 and 102 are independent claims.

Nakane discloses the compound 4-cyclohexylbutanoic acid and its synthesis. See page 5 of Office Action. Nakane does not describe the compound of formula (I) in amended claims 1, 22, and 102. In formula (I) of claims 1, 22, and 102, when L contains zero double bonds, one double bond, or two conjugated double bonds and A is C_{3-14} cycloalkyl, substituted phenyl or unsubstituted aryl, Y^1 is not a bond or CH_2 and Y^2 is not a bond or CH_2 . See amended claims 1, 22, and 102.

Accordingly, independent claims 1, 22, and 102 are not anticipated by Nakane. Claims 2-5 depend from claim 1 and are therefore patentable over Nakane for at least the reasons

described above. Applicants respectfully request reconsideration and withdrawal of this rejection.

Wittig

The Examiner has rejected claims 91-94 and 99 under 35 U.S.C. §102(b) as being anticipated by Wittig et al (Berichte, 1939, 72B, pages 1387-1398) ("Wittig"). Claim 91 is an independent claim.

Wittig discloses "the synthesis [of] compound 2-cyano-9-phenyl 2, 4, 6, 8 -nontetrenoic acid by hydrolysis of the corresponding methyl ester. This compound is present as a mixture of esters which presumably includes the all trans compound." See page 5 of the Office Action. Wittig however, does not describe the compound of formula (I) in claim 91. In formula (I) of claim 91, L is a straight C₃₋₆ hydrocarbon chain containing at least one double bond, at least one triple bond, or at least one double bond and one triple bond; said hydrocarbon chain being substituted with C₂₋₄ alkenyl, C₂₋₄ alkynyl, C₁₋₄ alkoxy, amino, nitro, C₃₋₅ cycloalkyl, 3-5 membered heterocycloalkyl, monocyclic aryl, 5-6 membered heteroaryl, C₁₋₄ alkylcarbonyloxy, C₁₋₄ alkylcarbonyl, or formyl. See amended claim 91. The compound described in Wittig is not within the scope of claim 91.

Accordingly, independent claim 91 is not anticipated by Wittig. Claims 92-94 and 99 depend from claim 91 and are therefore patentable over Wittig for at least the reasons described above. Applicants respectfully request reconsideration and withdrawal of this rejection.

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CONCLUSION

For the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the pending rejections. Applicants believe that the claims now pending are in condition for allowance.

Should any fees be required by the present Amendment, the Commissioner is hereby authorized to charge Deposit Account **19-4293**.

If, for any reason, a telephonic conference with the Applicant would be helpful in expediting prosecution of the instant application, the Examiner is invited to call Applicants' Attorney at the telephone number provided below.

Respectfully submitted,

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